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OFFICE OF PETITIONS

In re Application of	:	
Benneker et al.	:	DECISION
Application No. 09/200,743	:	ON APPLICATION FOR
Patent No. 7,598,271	:	PATENT TERM ADJUSTMENT
Filed: November 30, 1998	:	
Issued: October 6, 2009	:	
Atty Docket No. 091856-0111	:	
Title: CRYSTALLINE PAROXETINE	:	
METHANE SULFONATE	:	

This is a decision on the "RENEWED REQUEST FOR RECONSIDERATION OF PTA UNDER 37 C.F.R. § 1.705 & RESPONSE TO DECISION ON PETITION," filed on October 22, 2009 and supplemented on June 2, 2010. Patentee requests that the patent term adjustment be increased from two thousand and seventy-two (2072) days to two thousand, five hundred and fourteen (2514) days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by two thousand and seventy-three (2073) days is **GRANTED to the extent indicated herein.**

The \$200 fee that is associated with the filing of this petition will be charged to Deposit Account No. 19-0741 in due course, as authorized on the seventh page of this petition.

On October 1, 2008, Applicants submitted a "COMMUNICATION REGARDING PATENT TERM ADJUSTMENT," which was granted via the mailing of a decision on February 10, 2009.

On May 21, 2009, Applicants submitted a petition requesting that the patent term adjustment be increased to two thousand and seventy-two (2072) days, which was dismissed as premature via the mailing of a decision on August 26, 2009.

Application No. 09/200,743 matured into U.S. patent No. 7,598,271 on October 6, 2009, with a patent term adjustment of two thousand and seventy-two (2072) days.

Patentee has indicated that this patent is not subject to a terminal disclaimer.¹

With this petition, there are five periods of examination and applicant delay that are in dispute.

Regarding the first period that is in dispute, the Office agrees that the period of examination delay pursuant to 37 C.F.R. § 1.703(c)(1) totals 603 days,² and not 602 days.

Regarding the second period that is in dispute, the period from the filing date of the request for continued examination (RCE) to the issue date of the patent is not included in the "B" delay period. Therefore, the over three-year period begins on November 28, 2003 and ends on March 5, 2009, the day before the first RCE was filed, which amounts to 1925 (not 1926)³ days. See U.S.C. 154(b)(1)(B)(i).

Regarding the third period that is in dispute, the 215-day period of applicant delay discussed on the sixth page of this petition is not applicable.

Regarding the fourth period that is in dispute, the issue fee was paid on October 1, 2008, and a petition to withdraw the application from issuance was filed four months and 33 days later on March 6, 2009. Patentee argues this constitutes 33 days of examination delay pursuant to 37 C.F.R. § 1.703(a)(6),⁴ however no adjustment pursuant to this Rule is warranted: due to Applicant's request to withdraw the application from issuance, the Office was not required to issue the patent at that time.

Regarding the fifth period that is that is in dispute, Patentee argues that 2546 days of examination delay is warranted pursuant to 37 C.F.R. § 1.703(a)(2), as a response to a restriction requirement was filed on April 26, 2001 and a notice of allowance was mailed four months and 2,546 days later on

¹ Petition, page 6 and supplement to petition, page 6.

² Id.

³ See chart accompanying both this petition and supplement to petition.

⁴ Petition, page 5 and supplement to petition, page 5.

September 19, 2008. This calculation is erroneous, as the period of delay should have commenced with the four-month anniversary of the mailing of the decision on the interference on May 25, 2004, and not with the four-month anniversary of the filing of the response to the restriction requirement on April 26, 2001. As such, an adjustment of 1455 (not 2546) days is warranted. As was set forth on the third page of the decision of February 10, 2009:

...a favorable decision by the Board was mailed on May 25, 2004. The Office did not mail an Office action, a notice of allowance, in response until September 19, 2008, four months and 1455 days later. Pursuant to 37 CFR 1.703(a)(5), a period of adjustment of 1455 days should have been entered. Instead a period of adjustment of 2,546 days was entered. The period of adjustment of 2,546 days is being removed and the period of adjustment of 1455 days is being entered.

As such, the patent term adjustment is increased by 2073 days, not 2514 days.

The Office will *sua sponte* issue a certificate of correction. Pursuant to 37 C.F.R. § 1.322, the Office will not issue a certificate of correction without first providing assignee or patentee an opportunity to be heard. Accordingly, Patentee is given **one (1) month or thirty (30) days**, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under 37 C.F.R. § 1.136.

The application is being forwarded to the Certificates of Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **two thousand and seventy-three (2073) days**.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3225.

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 7,598,271 B1

DATED : **October 6, 2009**

DRAFT

INVENTOR(S): Benneker et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 2072 days

Delete the phrase “by 2072 days” and insert – by 2073 days--